

Application No. 09/835,673
Amendment dated June 11, 2003
Reply to Office Action of Feb. 11, 2003

REMARKS

Claims 1-30 are pending in the application. The Examiner has rejected Claims 1-14 and allowed Claims 15-30.

Claim Rejections – 35 U.S.C. §102

The Examiner has maintained the rejection of Claims 1, 2, 7-9 and 11 under 35 U.S.C. §102(e) as being anticipated by Bianchetti (U.S. Patent No. 6,095,810). In the Amendment of January 10, 2003, Applicants requested withdrawal of the 35 U.S.C. §102(e) rejection of Claims 1, 2, 7-9, and 11 because Bianchetti '810 did not disclose the drill head of Claims 1, 2, and 7; or the excavation means of Claims 8, 9, and 11.

The Examiner disagreed with Applicants' argument with respect to Bianchetti '810 because 1) "[N]o drill is being claimed, only a head. To call the head a 'drill' head is merely terminology and/or intended use which is given no patentable weight" (Office Action dated February 11, 2003, page 4, lines 11-13); and 2) because the Examiner contended that vibrating workpieces can be used to drill and evacuate. Applicants respectfully disagree with both of these contentions and submit that Claims 1, 2, 7-9, and 11 are patentable over Bianchetti '810 for the reasons advanced in Applicants' Amendment of January 10, 2003.

Responsive to the Examiner's first contention that the "drill head" called for in Independent Claim 1 and Claims 2, and 7 depending therefrom is merely an intended use and no drill is being claimed, Applicants respectfully direct the Examiner's attention to lines 8 and 9 of paragraph [0012] of the present specification wherein Applicants specifically identify "drill head" as "the operable end of an oscillating or rotating drill bit utilized to effect caries excavation." (emphasis added) Notwithstanding this definition of "drill head" contained in the patent specification, Applicants have amended Claim 1 to further clarify that a drill bit is claimed in Independent Claim 1. Because Bianchetti '810 does not disclose a drill bit as called for in Independent Claim 1, Applicants respectfully submit that Independent Claim 1 and Claims 2 and 7 depending therefrom are patentable over the cited reference to Bianchetti and respectfully

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request withdrawal of the 35 U.S.C. §102(e) rejection of these claims over Bianchetti '810.

Responsive to the Examiner's second contention, i.e., that vibrating workpieces can be used to drill and excavate, Applicants respectfully submit that the entire disclosure of Bianchetti '810 makes clear that the workpiece disclosed therein is utilized only to remove tartar and plaque from the tooth surface. See U.S. Patent No. 6,095,810, Abstract ("A workpiece (10) which effect removal of tartar and plaque from the tooth *surface*"); column 1, lines 9-11 ("The invention refers in particular to a surgical instrument employed by dentists for scaling and removing tartar and plaque from the tooth *surface*"); column 1, lines 20-23, column 2, lines 59-61 ("Plaque is a deposit of bacteria that forms through lack of hygiene or disease of the oral cavity; if it is not removed plaque creates the formation of tartar which is a calculus that forms on the tooth *surface*...hooked workpiece 10, which by entering into vibration, carries out removal of the tartar and plaque from the patient's teeth.") (Emphasis added). During the telephone interview of May 12, 2003, Applicants offered to submit a Declaration under 37 C.F.R. §1.132 indicating that the workpiece of Bianchetti '810 while possibly being capable of scratching or roughening the surface of a tooth would be incapable of drilling into the tooth and excavating carious tooth substance as would the drill bit of Independent Claim 1 and the excavation means of Independent Claim 8. The Examiner indicated no such Declaration under 37 C.F.R. §1.132 would be necessary and agreed that Bianchetti '801 does not disclose a drill bit or an excavating means as called for in Independent Claims 1 and 8, and Claims 2, 7, 9, and 11 depending therefrom. Because Bianchetti '801 does not disclose a drill bit or an excavation means as called for in Independent Claims 1 and 8, and Claims 2, 7, 9, and 11 depending therefrom, Applicants respectfully request withdrawal of the 35 U.S.C. §102(e) rejection of these claims over Bianchetti '810.

Claim Rejections – 35 U.S.C. §103

The Examiner maintained his rejection of Claims 3-6, 10, and 12 under 35 U.S.C. §103 as being unpatentable over Bianchetti '810 either alone or in combination with a secondary reference. Responsive to the rejection of Claims 3-6, 10, and 12, Applicants respectfully submit

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that Bianchetti '810 does not disclose or suggest the drill bit or excavation means of Independent Claims 1 and 8 and therefore respectfully request withdrawal of the 35 U.S.C. 103 rejection of Claims 3-6, 10, and 12 which all depend from one of Independent Claims 1 and 8.

The Examiner further maintained his rejection of Claims 13 and 14 under 35 U.S.C. §103 as being unpatentable over Meller (U.S. Patent No. 4,642,738) in view of Lafond (EP 0113152). Responsive to Applicants' argument in the Amendment dated January 10, 2003 that there is no motivation to combine Meller '738 and Lafond '152, the Examiner indicated that as stated in his previous rejection, the elements were merely listed together and that a list of prior art showing the same claimed structure properly meets a list of different structures in a claim. Without conceding that the Examiner's position with respect to elements listed together is correct, Applicants respectfully submit that Meller '738 does not disclose light source means for producing tooth luminescence mounted in a dental handpiece housing as called for in Independent Claim 13, as amended, and, therefore, merely combining the filter of Lafond '152 with the handpiece of Meller '738 does not yield the claimed invention of Applicants' Claim 13 and Claim 14 depending therefrom. During a recent telephone interview, the Examiner agreed that Meller '738 did not disclose light source means for producing tooth luminescence mounted in a dental handpiece housing as called for in Independent Claim 13, as amended. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103 rejection of Claims 13 and 14 over Meller '738 in view of Lafond '152.

Allowable Subject Matter

Applicants appreciate the Examiner's allowance of Claims 15-30.

Applicants appreciate the Examiner's courtesy in conducting a telephone interview on May 12, 2003 to discuss the present Office Action.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically Applicants respectfully submit that the application is in condition for allowance and such action is earnestly solicited.


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In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition and authorize that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 219/424-8000.

Respectfully submitted,

BAKER & DANIELS

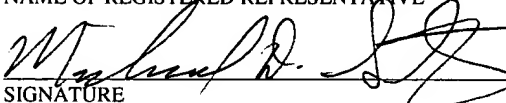

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June 11, 2003
DATE